

In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102(b), a primary tenet is that the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Many differences exist between the invention claimed in Meengs et al. and the currently claimed invention. To briefly summarize the distinguishing features and characteristics between the two, examiner notes that the inner calf of Meengs et al. is fabricated as separate loop from the outer cuff.

In contrast, as claimed in Claim 3 of the present invention, the leg-covering portion includes a foldable, outer cuff formed *integrally* with said leg-covering portion.

In addition, Meengs et al. fails to teach a selvaie makeup formed of several rounds of elastic yarn which serves not only as a covering shield for boot laces, but also serves to prevent the sock from sliding down the user's leg and into the boot through the course of the day.

Therefore, because of the aforementioned differences between Meengs et al. and the present invention, the examiner's rejection of Claims 1-4 under 35 U.S.C. 102(b) is inappropriate.

The examiner respectfully rejected Claims 5-8 under 35 U.S.C. 103(a) as being unpatentable over Meengs et al. in view of Kearns. The differences between Meengs et al. and the present invention have been stated above.

Kearns teaches a sock with simulated lace edge and a method of knitting the same. The examiner argues Kearns teaches a sock with elastic yarns in the selvage of an outer cuff portion.

Admittedly, Kearns teaches a decorative edge which includes a selvage makeup. However, as illustrated in FIG. 4 of Kearns, the selvage makeup #16 is positioned adjacent to course C-1 and is "formed of one or more rounds of yarn. . ." Column 2, lines 47-48. Thus, Kearns clearly fails to state yarn defined as being elastic.

In addition, Kearns fails to teach a foldable, outer cuff formed integrally with the leg-covering portion along a linearly elongated centerline thereof being designed and configured so as to fold downward.

Therefore, in view of the fact that Meengs et al. fails to teach a selvage makeup formed of several rounds of elastic yarn and further in view of Kearns' failure to teach a foldable, outer cuff which includes a selvage makeup formed of several rounds of *elastic* yarn designed so as to fold downward over a top portion of a boot, it would not have been obvious at the time the invention was made to one of ordinary skill in the art to which the invention pertains to provide the selvage area of the outer cuff of Meengs et al. with elastic yarns as shown by Kearns in order to increase the elasticity of the outer cuff portion of Meengs et al. and thereby maintain the cuff taut against the sock.

Furthermore, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument application wishes to point out that it is well established at law that for a proper *prima facie* rejection of a

claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of the combination of features and elements claimed in the dual sleeved sock and method of manufacturing the same. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be

a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,



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